



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,965	10/10/2000	Yuki Uchida	197849US-28	4230

22850 7590 05/18/2006

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

DUONG, THOMAS

ART UNIT PAPER NUMBER

2145

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,965

Applicant(s)

UCHIDA ET AL.

Examiner

Thomas Duong

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-8, 10-20, 22-32, 34-40, 42-45, 47-50, 54-56, 58-60, 62-64, 66-68, 70-72, and 74-76 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-20, 22-32, 34-40, 42-45, 47-50, 54-56, 58-60, 62-64, 66-68, 70-72, and 74-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/3/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.
2. Amendment received February 28, 2006 has been entered into record. *Claims 1-8, 10-20, 22-32, 34-40, 42-45, 47-50, 54-56, 58-60, 62-64, 66-68, 70-72, and 74-76* remain pending.

Response to Amendment

3. This office action is in response to the applicants Amendment filed on February 28, 2006. Applicant amended *claims 1, 13, 25-32, 37, 42, and 47* and canceled *claims 9, 21, 33, 41, 46, and 51*. *Claims 1-8, 10-20, 22-32, 34-40, 42-45, 47-50, 54-56, 58-60, 62-64, 66-68, 70-72, and 74-76* are presented for further consideration and examination.

Claim Objections

4. Claim 25 is objected to because of the following informalities:
 - “*comprising:*” and “*code mechanism comprising:*”
 - “*to said user..*”

Please make the appropriate corrections.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. With regards to claim 32, Applicants recite the limitation,

- “an eighth”, “a ninth”, “a tenth”

There is insufficient antecedent basis for this limitation in the claims. There are already “an eighth”, “a ninth”, and “a tenth” computer codes performing different functions in *claim 29*.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-8, 10-20, 22-32, 34-40, 42-45, 47-50, 54-56, 58-60, 62-64, 66-68, 70-72, and 74-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delano

Art Unit: 2145

(US006430558B1), in view of Busey et al. (US006377944B1), and further in view of Kalpio et al. (US006343323B1).

10. With regard to claims 1, 13, 25, 37, 42, and 47, Delano discloses,

- *providing said user with consulting advice regarding said request based upon data input by said user, said consulting advice including advice on document retrieval costs, document storage strategies, document storage organization, protection of secured documents, or delivery options of documents. (Delano, col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25; col.2, lines 37-62; col.7, line 59 – col.8, line 11)*

Delano teaches of a method for searching *“one or more knowledge databases formed by a combination of databases from a global network ... [including] steps of conducting search queries of content of at least one knowledge database, ranking content search results representative of the relative closeness of a requested search query to a search inputted by at least one user”* (Delano, col.3, lines 28-35). According to Delano, *“the collaborative search engine preferably also includes search content browsing means for browsing the content of the search results, search recommending means, e.g., a recommender, ... for recommending at least one of content providing (including content linking), alternative searching and alternative browsing queries to a user”* (Delano, col.5, lines 55-61) and presenting the user with the results. Delano anticipates of providing *“additional information or advertising content in the form of text, images, audio, video, or other media can advantageously be attached to content recommendations and notifications according to recommendation submitters,*

content providers, or other filter criteria” (Delano, col.2, lines 49-53). In addition, Delano states “the topics used to index the content in the Knowledge Base 25 can be organized into a hierarchy that can be browsed by Browser entities 34” (Delano, col.7, lines 59-61) and that “at each level, the subtopics can be presented to the user in a weighted ranking similar to the search mechanism, or can be presented in some other optimal ordering, such as most recently added or alphabetically. Subtopics can also be considered to be content items which can be recommended at appropriate topic levels by Recommender critics” (Delano, col.7, line 64 – col.8, line 3). Hence, Delano suggests organizing search strategies into topics and subtopics and presenting them to the user when appropriate.

- *selecting an application service provider based on said request; (Delano; col.2, line 63 – col.3, line 39; col.5, line 55 – col.6, line 25)*

Delano teaches of a method for searching “one or more knowledge databases formed by a combination of databases from a global network ... [including] steps of conducting search queries of content of at least one knowledge database, ranking content search results representative of the relative closeness of a requested search query to a search inputted by at least one user” (Delano, col.3, lines 28-35). Hence, one or more knowledge databases are used to obtain the user requested information.

- *forwarding said request to said application service provider; and (Delano, col.2, line 63 – col.3, line 39; col.5, line 55 – col.6, line 25)*

Delano teaches of a method for searching “one or more knowledge databases formed by a combination of databases from a global network ... [including] steps

Art Unit: 2145

of conducting search queries of content of at least one knowledge database, ranking content search results representative of the relative closeness of a requested search query to a search inputted by at least one user” (Delano, col.3, lines 28-35). Hence, one or more knowledge databases are used to obtain the user requested information.

- *receiving information from said application service provider indicating information of a document provided from said application service provider to said user.*

(Delano, col.2, line 63 – col.3, line 39; col.5, line 55 – col.6, line 25)

Delano teaches that “the collaborative search engine preferably also includes search content browsing means for browsing the content of the search results, search recommending means, e.g., a recommender, ... for recommending at least one of content providing (including content linking), alternative searching and alternative browsing queries to a user” (Delano, col.5, lines 55-61) and presenting the user with the results.

However, Delano does not explicitly disclose,

- *receiving a request from a remote user;*

Busey teaches,

- *receiving a request from a remote user; (Busey, col.4, lines 5-16; col.7, lines 19-45)*

Busey teaches of a “method for providing information in response to a customer request for information ... using a communication network coupled to a database and coupled to a customer input/output device to convey information to and from the customer, the method includes the following steps: receiving signals from the input/output device to indicate a customer query to the database [and] returning

information in response to the query" (Busey, col.4, lines 5-13). According to Busey, *"the web-based nature of the WRU interface to the customer means that the WRU's processes can be executing at one or more remote computers"* (Busey, col.7, lines 35-37).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Busey with the teachings of Delano to further enhance the search engine of Delano by allowing remote accessibility and distributing processing to the search engine through the use of a web-based user interface.

However, Delano and Busey do not explicitly disclose,

- *generating a unified bill from bills received from application service providers; and transmitting said unified bill to said user.*

Kalpio teaches,

- *generating a unified bill from bills received from application service providers; and transmitting said unified bill to said user.* (Kalpio, col.1, line 44 – col.3, line 5; col.3, lines 37-42; col.4, lines 10-15)

Kalpio discloses, *"the ISB is a software server platform which centralizes the logistic services on behalf of other content services. These logistic services include, without limitation, client identification and authentication, access control to the network resources, unified billing interface and client identification delivery for service customization"* (Kalpio, col.2, lines 8-13). In addition, according to Kalpio, *"the header is used to inform the intermediate node about billing information associated with a resource which can be purchased through a public connection network, e.g. the Internet, and which is intended to be intercepted by*

the intermediate node and to be redirected to a third node (the 'ISB') managing the actual billing" (Kalpio, col.4, lines 10-15). Hence, Kalpio teaches of an ISB software server platform that is responsible for collecting billing information from separate services and consolidating them into a unified bill and delivering to the user.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Kalpio with the teachings of Delano and Busey to further enhance the search engine of Delano by allowing remote accessibility and distributing processing to the search engine through the use of a web-based user interface. In addition, according to Kalpio, *"the present invention relates to a method and apparatus for retrieving from a content server over a data network and in particular, though not necessarily, to a method and apparatus for enhancing World Wide Web services"* (Kalpio, col.1, lines 7-11) and that by *"implementing the interface for these logistic services for standard web server with standard HTML, such that there is no need to make any proprietary modification"* (Kalpio, col.2, lines 13-17).

11. With regard to claims 2, 4, 14, 16, 26, and 28, Delano, Busey, and Kalpio disclose,

- *further comprising the step of providing said user with said document from said application service provider.* (Delano, col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)
- *further comprising the step of searching for said document in said application service provider.* (Delano, col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)

12. With regard to claims 3, 15, and 27, Delano, Busey, and Kalpio disclose,
- *further comprising the step of providing said application service provider with a user access level.* (Busey, col.6, line 62 – col.7, line 5; col.11, lines 8-20)
-
13. With regard to claims 5-7, 17-19, and 29-31, Delano, Busey, and Kalpio disclose,
- *wherein the step of providing said documents to said user comprises:*
 - *delivering a print out of said document to said user; and*
 - *providing said user with a URL of said document.* (Delano, col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)
 - *wherein the step of providing said document to said user comprises transmitting said document to a user storage device.* (Delano, col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)
 - *wherein the step of providing said document to said user comprises transmitting said document to a user display device.* (Delano, col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)
14. With regard to claims 8, 20, and 32, Delano, Busey, and Kalpio disclose,
- *further comprising the steps of:*
 - *retrieving said document;*
 - *formatting said document into a format requested by said user;*
 - *providing said user with said document formatted in said formatting step.*
(Delano, col.2, line 63 – col.3, line 39; col.5, line 55 – col.6, line 25)

Art Unit: 2145

15. With regard to claims 10, 22, and 34, Delano, Busey, and Kalpio disclose,
 - *wherein the receiving information step comprises receiving the information which is a billing information.* (Kalpio, col.1, line 44 – col.3, line 5; col.3, lines 37-42; col.4, lines 10-15)
16. With regard to claims 11-12, 23-24, and 35-36, Delano, Busey, and Kalpio disclose,
 - *wherein the receiving information step comprises receiving the information which is the document.* (Delano, col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)
 - *wherein the receiving information step comprises receiving the information which is a URL for said document.* (Delano, col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)
17. With regard to claims 38, 43, and 48, Delano, Busey, and Kalpio disclose,
 - *wherein the step of receiving said document and storage information is performed after a storage time period associated with said document to be transmitted.* (Delano, col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)
18. With regard to claims 39, 44, and 49, Delano, Busey, and Kalpio disclose,
 - *wherein the steps of receiving and transmitting storage information comprises receiving and transmitting a user access level.* (Busey, col.6, line 62 – col.7, line 5; col.11, lines 8-20)

Art Unit: 2145

19. With regard to claims 40, 45, and 50, Delano, Busey, and Kalpio disclose,
- *wherein the step of selecting said application service provider is performed based on a document type for said document.* (Busey, col.6, line 62 – col.7, line 5; col.11, lines 8-20)
20. With regard to claims 54, 58, 62, 66, 70, and 74, Delano, Busey, and Kalpio disclose,
- *wherein the consulting advice provided to said user includes advice on document search strategies, or updating of documents.* (Delano, col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)
21. With regard to claims 55-56, 59-60, 63-64, 67-68, 71-72, and 75-76, Delano, Busey, and Kalpio disclose,
- *wherein the data input by said user upon which the consulting advice is provided is obtained via a user interaction device by said user in response to a series of questions.* (Delano, col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)
 - *wherein the data input by said user upon which the consulting advice is provided is generated based upon previously acquired data from said user.* (Delano, col.2, line 63 – col.3, line 39; col.4, lines 10-28; col.5, line 55 – col.6, line 25)

Response to Arguments

22. Applicant's arguments with respect to *claims 1, 13, 25, 37, 42, and 47* have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2145

Conclusion

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Duong whose telephone number is 571/272-3911. The examiner can normally be reached on M-F 7:30AM - 4:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason D. Cardone can be reached on 571/272-3933. The fax phone numbers for the organization where this application or proceeding is assigned are 571/273-8300 for regular communications and 571/273-8300 for After Final communications.

Thomas Duong (AU2145)

May 11, 2006

A handwritten signature in black ink, appearing to read 'Jason D. Cardone', with a long horizontal stroke extending to the right.

Jason D. Cardone

Supervisory PE (AU2145)